

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 103

Claims 1-3, 20-23, and 39-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0010757 ("the Granik publication") in view of U.S. Patent Application Publication No. 2004/0117259 ("the Morrisroe publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, claims 23 and 39-42 have been rejected by the Examiner under separate grounds and appear to have been mistakenly included in this ground of rejection. Thus, claims 23 and 39-42 are each addressed below under their

respective grounds of rejection.

Second, since claims 2, 3, 21 and 22 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Third, independent claims 1 and 20 have been amended to include features from dependent claims 40 and 42, in addition to features described on page 13, lines 3-17 of the present application. Since dependent claims 40 and 42 were rejected under 35 U.S.C. § 103(a) in view of the Granik and Morrisroe publications, as well as U.S. Patent Application Publication No. 2003/0105677 ("the Skinner publication"), claims 1 and 20 are analyzed in view of the Skinner publication as well.

Independent claims 1 and 20, as amended, are not rendered obvious by the Granik, Morrisroe and Skinner publications because these references neither teach, nor make obvious, acts of encoding or decoding ad properties included in a click URL wherein the encoded ad properties include *all of (A) a topic or concept associated with a Web page with which the ad was served, (B) a time the ad was served or rendered, (C) information about other ads that were rendered along with the ad, (D) a geolocation to which the ad was served, (E) an identity of a server that chose the ad, and (F) a digital signature generated based on the other ad properties included in the click URL.*

In rejecting claims 40 and 42, the Examiner contends that the Skinner publication teaches "that is well known to track both advertiser charges and search terms that generated the page" and further cites a portion of the Skinner publication which states:

...The tracking URL has embedded within it a keycode to help identify the OMM website 34 which was used to direct the user 32 to the advertiser's web site 42, as well as the search term which was used at the OMM website 34.").

(Paper No. 20091109, page 5) However, the inclusion of "search term which was used at the OMM website" does not teach or make obvious that the encoded ad properties include a topic or concept associated with a Web page with which the ad was served. Furthermore, in addition to including a topic or concept associated with a Web page with which the ad was served, claims 1 and 20 were amended to also include all of (B) a time the ad was served or rendered, (C) information about other ads that were rendered along with the ad, (D) a geolocation to which the ad was served, (E) an identity of a server that chose the ad, and (F) a digital signature generated based on the other ad properties included in the click URL.

Thus, claims 1 and 20, as amended, are not rendered obvious by the Granik, Morrisroe and Skinner publications for at least this reason.

Claims 4-9 and 23-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable for the reasons set forth above, further in view of the paper, T. Berners-Lee, et al, "Uniform Resource Identifiers (URI): General Syntax," Network Working Group, Request for Comments: 2396, (August 1998) ("RFC 2396"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 4-9 and 23-28 directly or indirectly depend from claims 1 and 20, respectively. The purported teachings of RFC 2396 would not compensate for the deficiencies of the Granik, Morrisroe and Skinner publications with respect to claims 1 and 20, as amended (discussed above), regardless of the scope of the purported disclosure in RFC 2396, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 4-9 and 23-28 are not rendered obvious by the cited references for at least this reason.

Claims 10, 19, 29 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik publication in view of the Morrisroe publication and further in view of U.S. Patent Application Publication No. 2003/0035139 ("the Tomita publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The applicants continue to maintain that one skilled in the art would not have combined the Granik, Morrisroe and Tomita publications as proposed by the Examiner. The Granik publication generally concerns "[a]n Internet/world-wide-web-based advertisement replacement system and methodology for *replacing advertising content on web-based communications received by users*. [Emphasis added.]" (Abstract of the Granik publication) Specifically, the section of the Granik publication cited by the Examiner states:

Particularly, in response to a user click on a replaced ad, a web-based communication 32 is generated that includes a re-direct ad URL including: 1) an encrypted identifier that identifies the user on the re-direct server; and 2) an ultimate destination website code.

(Paragraph [0043] of the Granik publication) By contrast, the section of the Tomita publication cited by the Examiner provides:

When the CPU 201 judges that firmware is attached (step S126, Yes), it extracts the part in the body section that corresponds to the firmware (step S127). As has been described, the data of the firmware has been converted to US-ASCII code according to Base 64 conversion in order to be attached to the e-mail. Therefore, the CPU 201 converts the character string back to binary data according to reverse Base64 conversion (step S128), and then stores the resulting binary data in the hard disk drive 205 (step S129).

(Paragraph [0213] of the Tomita publication) Thus, the Tomita publication concerns a system and method of **implementing firmware updates in coordination with image processing jobs in an image processing apparatus**. Firmware data is "converted to US-ASCII code according to Base 64 conversion" and sent via e-mail to the image processing apparatus which then converts it back to binary data. (See Abstract and paragraphs [0018] and [0213] of the Tomita publication.)

Neither the Granik publication, the Morrisroe publication, nor the Tomita publication, contains any

teaching, suggestion, or obvious reason to combine these disparate references as proposed by the Examiner to produce the claimed invention. That is, one skilled in the art would not have combined a system *for replacing advertising content on web-based communications received by users* with a system *for implementing firmware updates in coordination with image processing jobs* in an image processing apparatus. Since there is no obvious reason to combine the references, this rejection is apparently based on information from the applicants' own disclosure -- that is, based upon improper hindsight reasoning. The Examiner should only take into account "knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure...." (*In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).) For example, the Examiner does not demonstrate how the proposed combination applies a known technique to a known device (method, or product) ready for improvement to yield predictable results.

Consequently, claims 10 and 29, as amended, are not rendered obvious by the cited references for at least this reason. Since claim 19 depends from claim 10, and since claim 38 depends from claim 29, these claims are similarly not rendered obvious by the Granik, Morrisroe and Tomita publications.

Finally, regardless of the absence or presence of an obvious reason to combine the references, claims 10 and 29, as amended, are not rendered obvious by the Granik, Morrisroe and Tomita publications for the reasons discussed above with respect to claims 1 and 20, and because the cited references do not teach, or make

obvious (a) representing each of ad properties of an ad with a binary value, (b) concatenating each of the binary values to define a sequence of bits, (c) encoding the sequence of bits into a sequence of characters, wherein each of the characters is selected from a set of K legal characters, and (d) providing the sequence of characters in a click URL of the ad.

In rejecting claims 10 and 29, the Examiner cites paragraph [0213] of the Tomita publication as teaching that "it is well known to encode binary data and parameters as a string of valid characters" and therefore teaches elements (a) through (c) in claims 10 and 29. (See Paper No. 20091109, page 8.) In addition, the applicants note that, although not explicitly stated, the Examiner is apparently using the purported teachings of the Granik publication as teaching element (d) of claims 10 and 29. The applicants respectfully disagree.

The Tomita publication concerns an image processing apparatus having a printer controller which "receives firmware attached to e-mail from a mail server, downloads the firmware to an internal hard disk drive, and registers the job at the bottom of a job registration table." (Abstract of the Tomita publication) Specifically, as discussed above, the portion of the Tomita publication cited by the Examiner provides:

When the CPU 201 judges that firmware is attached (step S126, Yes), it extracts the part in the body section that corresponds to the firmware (step S127). As has been described, the data of the firmware has been converted to US-ASCII code according to Base 64 conversion in order to be attached to the e-mail. Therefore,

the CPU 201 converts the character string back to binary data according to reverse Base64 conversion (step S128), and then stores the resulting binary data in the hard disk drive 205 (step S129).

(Paragraph [0213] of the Tomita publication) The Tomita publication is discussing a system and method of implementing firmware updates in an image processing apparatus. Firmware data is "converted to US-ASCII code according to Base 64 conversion" and sent via e-mail to the image processing apparatus which then converts it back to binary data. As can be appreciated from the foregoing, the Tomita publication does not teach or make obvious (a) *representing each of ad properties of an ad with a binary value*, (b) concatenating each of the binary values to define a sequence of bits, and (c) encoding the sequence of bits into a sequence of characters, wherein each of the characters is selected from a set of K legal characters. Rather, the Tomita publication merely converts firmware data into "US-ASCII code according to Base 64 conversion in order to be attached to the e-mail." (Paragraph [0213] of the Tomita publication) The Tomita publication has nothing to do with representing ad properties of an ad in binary value. Furthermore, the purported teachings of the Granik and Morrisroe publications fail to compensate for the deficiencies of the Tomita publication discussed above.

Thus, claims 10 and 29, as amended, are not rendered obvious by the Granik, Morrisroe and Tomita publications for at least this additional reason. Since claim 19 depends from claim 10, and since claim 38 depends from



claim 29, these claims are similarly not rendered obvious by the Granik, Morrisroe and Tomita publications.

Claims 39-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik publication in view of the Morrisroe publication and further in view of U.S. Patent Application Publication No. 2003/0105677 ("the Skinner publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since claims 39-42 have been canceled, this ground of rejection is rendered moot.

#### Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.


Any arguments made in this amendment pertain *only* to the specific aspects of the invention *claimed*. Any claim amendments or cancellations, and any arguments, are made *without prejudice to, or disclaimer of*, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to

assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

May 24, 2010

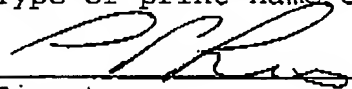
  
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